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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,277	02/06/2004	Akira Nomiya	500.43493X00	2187

20457 7590 07/30/2007
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EXAMINER

MORRISON, THOMAS A

ART UNIT	PAPER NUMBER
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3653

NOTIFICATION DATE	DELIVERY MODE
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07/30/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/772,277	Applicant(s) NOMIYAMA ET AL.	
	Examiner Thomas A. Morrison	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 21-23 and 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 2003/0127509.

Regarding claim 21, Figs. 1-23 show an apparatus (Fig. 1) for receiving and paying paper moneys, comprising:

a stacking device (e.g., Fig. 17) for stacking the paper moneys therein;

a paper money size detector (numbered paragraph [0093]) to detect sizes of the paper moneys to be stacked in the stacking device (Fig. 17);

a travel regulating member (including 812) to regulate travels of the paper moneys to be stacked in the stacking device (Fig. 17); and

a controller (numbered paragraph [0075]) to control the travel regulating member (including 812); wherein after the travel regulating member (including 812) receives and

holds thereon only the paper moneys of the same size detected by the paper money size detector (numbered paragraph [0093]), the travel regulating member (including 812) is controlled by the controller (numbered paragraph [0075]) to be rotated to move the received and held paper moneys to be stacked into the stacking device (Fig. 17). This wherein limitation can be met by only feeding one type of money (e.g., only \$5 bills) into the apparatus of U.S. Patent Publication No. 2003/0127509.

Alternatively, it is noted that in the recitation “wherein **after the travel regulating member receives and holds thereon only the paper moneys of the same size detected by the paper money size detector**, the travel regulating member is controlled by the controller to be rotated to move the received and held paper moneys to be stacked into the stacking device”, the bolded portion of this recitation is a conditional limitation that need **not** ever occur. As such, this limitation need **not** be given patentable weight. In either case, U.S. Patent Publication No. 2003/0127509 meets the limitations of claim 21.

Regarding claim 22, numbered paragraphs [0086-0087] disclose that the controller detects an amount of the paper moneys received and held by the travel regulating member (including 812) to control the travel regulating member (including 812) so that the travel regulating member (including 812) moves the received and held paper moneys to be stacked into the stacking device (Fig. 17).

Regarding claim 23, Figs. 1-23 show that the travel regulating member (including 812) **comprises** a single stacked-money supporting arm.

Regarding claim 25, Figs. 1-23 show an apparatus for receiving and paying paper moneys, comprising:

a stacking device (Fig. 17) for stacking the paper moneys therein,

a paper money size detector (numbered paragraph [0093]) to detect sizes of the paper moneys to be stacked in the stacking device (Fig. 17),

a travel regulating member (including 812) to regulate travels of the paper moneys to be stacked in the stacking device (Fig. 17), the travel regulating member (including 812) adapted to hold a plurality of sheets of the paper moneys in a stack at a same time, and

a controller (numbered paragraph [0075]) to control the travel regulating member (including 812), wherein after the travel regulating member receives and holds thereon the plurality of sheets of the paper moneys of the same size detected by the paper money size detector, the travel regulating member is controlled by the controller to be rotated to move the received and held plurality of sheets of the paper moneys to be stacked into the stacking device.

Regarding the recitation "wherein **after the travel regulating member receives and holds thereon the plurality of sheets of the paper moneys of the same size detected by the paper money size detector**, the travel regulating member is controlled by the controller to be rotated to move the received and held plurality of sheets of the paper moneys to be stacked into the stacking device", the bolded portion of this recitation is a conditional limitation that need **not** ever occur. As such, this limitation need **not** be given patentable weight.

Regarding claim 26, Figs. 1-23 show that the travel regulating member (including 812) **comprises** a single stacked-money supporting arm.

Regarding claim 27, numbered paragraphs [0086] – [0087] disclose a stacked-money volume detecting member to detect the volume of stacked money stacked adjacent the travel regulating member.

2. Claims 21-23 and 25-27 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent Publication No. 2003/0127509. In particular, this reference discloses all of the limitations of claims 21-23 and 25-27. Note: the comparison between the elements of claims 21-23 and 25-27 and the elements of U.S. Patent Publication No. 2003/0127509 is the same as the comparison outlined above in the rejection under 35 U.S.C. 102(e).

3. Claims 21, 23, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by International Application Publication No. WO00/24662 (cited in the 10/19/04 IDS).

Regarding claim 21, Figs. 1-5 show an apparatus for receiving and paying paper moneys, comprising:

- a stacking device (Fig. 2) for stacking the paper moneys therein;
- a paper money size detector (e.g., page 3, lines 5-8 and page 7, line 34 to page 8, line 22) to detect sizes of the paper moneys to be stacked in the stacking device (Fig. 2);
- a travel regulating member (5) to regulate travels of the paper moneys to be stacked in the stacking device (Fig. 2); and

a controller (whatever controls element 5) to control the travel regulating member (5);

wherein after the travel regulating member (5) receives and holds thereon only the paper moneys of the same size detected by the paper money size detector, the travel regulating member (5) is controlled by the controller (including 11) to be rotated to move the received and held paper moneys to be stacked into the stacking device (Fig. 2). This "wherein limitation" can be met by only feeding one type of money (e.g., only \$5 bills) into the apparatus of WO00/24662.

Alternatively, it is noted that in the recitation "wherein **after the travel regulating member receives and holds thereon only the paper moneys of the same size detected by the paper money size detector**, the travel regulating member is controlled by the controller to be rotated to move the received and held paper moneys to be stacked into the stacking device", the bolded portion of this recitation is a conditional limitation that need **not** ever occur. As such, this limitation need **not** be given patentable weight. In either case, WO00/24662 meets the limitations of claim 21.

Regarding claim 23, Figs. 1-5 show that the travel regulating member **comprises** a single stacked-money supporting arm.

Regarding claim 25, Figs. show an apparatus for receiving and paying paper moneys, comprising:

a stacking device (Fig. 2) for stacking the paper moneys therein,

a paper money size detector (e.g., page 3, lines 5-8 and page 7, line 34 to page 8, line 22) to detect sizes of the paper moneys to be stacked in the stacking device (Fig. 2),

a travel regulating member (5) to regulate travels of the paper moneys to be stacked in the stacking device (5), the travel regulating member (5) adapted to hold a plurality of sheets of the paper moneys in a stack at a same time, and

a controller (whatever controls element 5) to control the travel regulating member (5),

wherein after the travel regulating member receives and holds thereon the plurality of sheets of the paper moneys of the same size detected by the paper money size detector, the travel regulating member is controlled by the controller to be rotated to move the received and held plurality of sheets of the paper moneys to be stacked into the stacking device.

Regarding the recitation "wherein **after the travel regulating member receives and holds thereon the plurality of sheets of the paper moneys of the same size detected by the paper money size detector**, the travel regulating member is controlled by the controller to be rotated to move the received and held plurality of sheets of the paper moneys to be stacked into the stacking device", the bolded portion of this recitation is a conditional limitation that need **not** ever occur. As such, this limitation need **not** be given patentable weight.

Regarding claim 26, Figs. 1-5 show that the travel regulating member (5) **comprises** a single stacked-money supporting arm.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0127509 as applied to claim 21 above, and further in view of U.S. patent No. 6,331,000 (Beskitt et al.). U.S. Patent Publication No. 2003/0127509 discloses all of the limitations of claim 24, except for the travel regulating member (including 812) comprising not more than two stacked-money supporting arms.

The Beskitt et al. patent discloses that it is well known to provide an apparatus for receiving and paying paper moneys (Fig. 1) with a travel regulating member (90) having not more than two stacked-money supporting arms (see e.g., Fig. 3). The Beskitt et al. patent shows that the travel regulating member (90) has a gripper member (138) for the purpose of securely holding sheets as they are conveyed by the travel regulating member (90). See e.g., Figs. 3-5 and the Abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the apparatus of U.S. Patent Publication No. 2003/0127509 with a travel regulating member with only one gripper arm (i.e., one stacked-money supporting arm) for the purpose of purpose of securely holding sheets as they are conveyed, as taught by Beskitt et al. Thus, all of the limitations of claim 24 are met.

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over International Application Publication No. WO00/24662 as applied to claim 21 above, and further in view of U.S. patent No. 5,476,256 (Fortuna et al.). International Application Publication No. WO00/24662 discloses all of the limitations of claim 24, except for the travel regulating member (5) comprising not more than two stacked-money supporting arms.

The Fortuna et al. patent discloses that it is well known to provide a paper handling apparatus with a travel regulating member (21) having not more than two stacked-money supporting arms (24). See e.g., Figs. 1-4. Figs. 1-4 and the abstract disclose that the Fortuna et al. travel regulating member (21) includes a disc with passive registration system (including 32) for the purpose of achieving positive sheet control by applying force against the sheets while the sheets are located in the travel regulating member (21). See also column 1, lines 60-67. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the apparatus of International Application Publication No. WO00/24662 with a travel regulating member having two registration arms (i.e., two stacked-money supporting arms) for the purpose of achieving positive sheet control by applying force against the sheets while the sheets are located in the two stacked-money supporting arms, as taught by Fortuna et al. Thus, all of the limitations of claim 24 are met.

Response to Arguments

6. Applicant's arguments filed 5/14/2007 have been fully considered but they are not persuasive.

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Applicant argues

More particularly, neither of the cited art provides a disclosure that teaches a travel regulating member that is able to receive and hold thereon a plurality of only paper moneys of the same size detected by the paper money size detector. Nor does the prior art then teach or disclose the travel regulating member being rotated to move the received and held paper moneys to be stacked into the stacking device, as is described on pp. 28, line 8 - pp. 30, line 20, and as shown in Figs. 27A - 27D.

Then, applicant argues

Nomiyama ('509)

As particularly shown in Figs. 20 and 21 of Nomiyama ('509) said prior art teaches a stacking assist member (812) that only accumulates one bill at a time, large or small, before moving the bill into the charging/recovery box (8). The present invention, on the other hand, discloses receiving and holding a plurality of paper moneys of the same size, then moving those stacked and held paper moneys into the stacking device.

Then, applicant argues

PCT ('662)

WO00/24662 discloses a Sheet Stacking Apparatus that must be manually adjusted by an operator (pp. 8, lines 7 - 9), that does not have a paper money size detector for detecting sizes of paper moneys, does not have a travel regulating member, does not have a controller for controlling the travel regulating member, nor does the prior art disclose receiving and holding only paper moneys of the same size before moving the received moneys into a stacking device. For at least these reasons, the claims of the instant application clearly distinguish over the disclosure of PCT ('662).

In response, independent claim 21 recites "a paper money size detector to detect sizes of the paper moneys to be stacked in the stacking device; a travel regulating member to regulate travels of the paper moneys to be stacked in the stacking device; and a controller to control the travel regulating member; wherein after the travel regulating member receives and holds thereon only the paper moneys of the same size detected by the paper money size detector, the travel regulating member is controlled

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by the controller to be rotated to move the received and held paper moneys to be stacked into the stacking device.”

Regarding the paper money size detector limitation, International Application Publication No. WO00/24662 discloses a paper money size detector (e.g., page 3, lines 5-8 and page 7, line 34 to page 8, line 22), as claimed.

Regarding the travel regulating member limitation, claim 21 does **not** require a travel regulating member that is able to receive and hold thereon **a plurality** of only paper moneys of the same size detected by the paper money size detector. Rather, an anticipatory device can receive and hold only one bill at a time and still meet the limitations of claim 21. The travel regulating member limitation is met by element 812 of U.S. Patent Publication No. 2003/0127509 as outlined in the rejection of claim 21 above. Also, the travel regulating member limitation is met by element 5 of International Application Publication No. WO00/24662 as outlined in the rejection of claim 21 above.

With regard to the “wherein limitation” in claim 21, this limitation can be met by only feeding one type of money (e.g., only \$5 bills) into the apparatus of U.S. Patent Publication No. 2003/0127509 or the apparatus of International Application Publication No. WO00/24662. Thus, these prior art references meet the limitations of claim 21.

Alternatively, it is noted that in claim 21 in the recitation “wherein **after the travel regulating member receives and holds thereon only the paper moneys of the same size detected by the paper money size detector**, the travel regulating member is controlled by the controller to be rotated to move the received and held paper moneys to be stacked into the stacking device”, the bolded portion of this recitation is a

conditional limitation that need **not** ever occur. As such, this limitation need **not** be given patentable weight. In either case, U.S. Patent Publication No. 2003/0127509 and International Application Publication No. WO00/24662 both meet the limitations of claim 21.

Referring now to independent claim 25, this claim recites “the travel regulating member **adapted to** hold a plurality of sheets of the paper moneys in a stack at a same time, and a controller to control the travel regulating member, wherein after the travel regulating member receives and holds thereon the plurality of sheets of the paper moneys of the same size detected by the paper money size detector, the travel regulating member is controlled by the controller to be rotated to move the received and held plurality of sheets of the paper moneys to be stacked into the stacking device.” (emphasis added).

With regard to the recitation “adapted to...”, it is noted that this wording does **not** positively recite that the travel regulating member actually performs the function set forth after “adapted to”. Accordingly, this recitation has not been given patentable weight. It is the examiner’s position that the travel regulating member (including 812) of U.S. Patent Publication No. 2003/0127509 can be “adapted to” hold a plurality of sheets of the paper moneys in a stack at a same time, as set forth in claim 25. Likewise, it is the examiner’s position that the travel regulating member (5) of International Application Publication No. WO00/24662 can be “adapted to” hold a plurality of sheets of the paper moneys in a stack at a same time, as set forth in claim 25.

In claim 25 in the recitation “wherein **after the travel regulating member receives and holds thereon the plurality of sheets of the paper moneys of the same size detected by the paper money size detector**, the travel regulating member is controlled by the controller to be rotated to move the received and held plurality of sheets of the paper moneys to be stacked into the stacking device”, the bolded portion of this recitation is a conditional limitation that need **not** ever occur. As such, this limitation need **not** be given patentable weight. Thus, U.S. Patent Publication No. 2003/0127509 and International Application Publication No. WO00/24662 both meet the limitations of claim 25.

In addition, applicant argues

Possible Rejections Based on 35 USC 103

Applicant wishes to point out that the prior art reference of Nomiya ('509) is assigned to the same assignee of the present application. Therefore, under 35 USC 103(c), Nomiya ('509) may not be used in combination with any other prior art reference to reject the claims under 35 USC 103.

One rejection under 35 U.S.C. 103 in view of Nomiya ('509) and U.S. patent No. 6,331,000 (Beskitt et al.) is outlined above. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

7/19/2007


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